

REMARKS

In the Office Action mailed July 24, 2008,¹ the Examiner:

- (1) rejected claims 25-31 and 37-41 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter; and
- (2) rejected claims 32-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,601,044 to Wallman (*Wallman*)

By this Amendment, claims 25-31 and 37-41 are amended. Thus, claims 25-41 are pending in this application.

1. Rejection Under 35 U.S.C. § 101

Applicant respectfully traverses the rejection of claims 25-31 and 37-41 under 35 U.S.C. § 101. Specifically, the Examiner alleges that the claims are not tied to “any other statutory subject matter, such as a computer platform” and thus the claims are directed to “Functional Descriptive Material *Per Se*.” See Office Action, pg. 3.

Without conceding the propriety of this characterization of claims 25-31 and 37-41, claims 25-31 and 37-41 are amended to recite, *inter alia*, a “computer-readable storage medium” that is encoded with a method or a computer program. Thus, claims 25-31 and 37-41 are even more clearly tied to statutory subject matter. Accordingly, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 101. Furthermore, as claims 25-31 and 37-41 are not currently rejected over the cited art, Applicant respectfully requests allowance of claims 25-31 and 37-41.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

2. Rejection Under 35 U.S.C. § 103

Applicant respectfully traverses the rejection of claims 32-36 under 35 U.S.C. § 103(a) as being unpatentable over *Wallman*. The Office Action failed to establish a *prima facie* case of obviousness.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. In addition, when "determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103(a) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966) The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the difference between the claimed invention and the prior art." M.P.E.P. § 2141(II). Office personnel must explain why the

difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

In the Office Action, the Examiner alleges that the "claimed invention recites an intended use." See Office Action, pg. 4. (emphasis in original). The Examiner acknowledges that *Wallman* fails to discuss the alleged "intended use," but alleges that (1) *Wallman*'s system "is capable of performing the intended use" and (2) it would have been obvious to modify *Wallman* to include the intended use "for the purpose of providing automated coaching for a financial modeling and counseling in a specific way." See Office Action, pg. 4. The Office Action fails to identify which portion of the claim recites an "intended use," what the "intended use" actually is, or how *Wallman*'s system is capable of performing the intended use. See *id*.

First, Applicant submits that the language recited in claim 32 does not state a purpose or an intended use of the claimed invention, but rather discloses fundamental characteristics of the claimed invention that are properly construed as limitations of the claim. Furthermore, since the Office Action does not clearly indicate which portions of claim 32 recite the alleged "intended use," the Office Action has failed to establish a *prima facie* case of obviousness.

Second, the Office Action does not provide any support for the conclusion that *Wallman* is capable of performing the alleged "intended use." For example, while *Wallman* may disclose a "processing unit," which Applicant does not concede, and this processing unit may be "for" processing financial data, there is no indication that *Wallman*'s processing unit is capable of processing personal financial data "using automated rules-based coaching algorithms" as recited in claim 32. Indeed, *Wallman*'s

alleged "processing unit" and the processing unit of the claimed invention may need to be structurally different to carry out the required processing.

Third, the alleged motivation to modify *Wallman* "for the purpose of providing automated coaching for a financial modeling and counseling in a specific way" is improper. For example, the phrase "automated coaching for a financial modeling and counseling," taken directly from the language of Applicant's claims, strongly suggests that hindsight was impermissibly applied. Furthermore, the allegation that one would be motivated to modify *Wallman* to provide automated coaching in a "specific way," such as the "way" of the claimed invention is without merit. Simply alleging that one of ordinary skill in the art would be motivated to modify *Wallman* to result in the claimed invention because one of ordinary skill in the art would want that result is insufficient without indicating why one of ordinary skill in the art would make the modification. Accordingly, the motivation to modify *Wallman* stated in the Office Action is improper.

In view of the mischaracterization of Applicant's claims, mischaracterization of *Wallman*, and the failure to provide a proper motivation to modify *Wallman*, the Office has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 32, and claims 33-36 depending therefrom. Thus, the Office has failed to clearly articulate a reason why claims 32-36 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 32-36, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

4. **Conclusion**

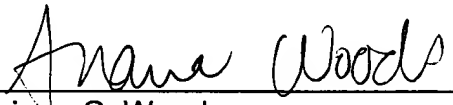
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 25, 2008

By: 
Ariana G. Woods
Reg. No. 58,997